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REED SMITH LLP
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA PA 19103

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OFFICE OF PETITIONS

In re Application of
Turner, et al.

Application No. 10/015,077

Filed: October 26, 2001

Attorney Docket No.01-40169-US

For: SYSTEM AND METHOD FOR
USING AN INSTANT MESSAGING
ENVIRONMENT TO ESTABLISH A
HOSTED APPLICATION SHARING
SESSION

DECISION ON
PETITION

This is a decision on the petition, filed August 27, 2002, requesting that pages 19, 20, 21, 22, and 23 of the specification be accorded a filing date of October 26, 2001.

The application was filed on October 26, 2001. On June 27, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Items in a Nonprovisional Application"(Notice) informing petitioners that pages 19, 20, 21, 22, and 23 of the specification appeared to have been omitted.

In response to the Notice, petitioners timely filed the present petition. Petitioners request the October 26, 2001 filing date for pages 19, 20, 21, 22, and 23 on the basis that the allegedly omitted pages were received in the Patent and Trademark Office (PTO) on October 26, 2001. In support, the petition is accompanied by (1) a declaration of the attorney of record who reviewed the application and attests to the fact that it was complete when filed, (2) a copy of applicants' postcard receipt **without** a date stamp from the Office, and (3) applicants' Express Mail label with a USPS postmark of October 26, 2001.

The declaration by counsel submitted with the petition states without equivocation or doubt that he checked the assembled application papers in the Express Mail envelope to determine that the application included all pages of the specification.

The Office file is the official record of what was mailed by Express Mail or filed on October 26, 2001. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. In this regard, declarations by individuals involved in the preparation and mailing of the original application reciting their personal recollection or belief of what was contained in the application that they reviewed and/or mailed are no more persuasive of what was actually mailed than the contents of the official

record. Such declarations, as in this case, are usually made months after the actual events recited. In this case, the declaration supplied on August 27, 2002 was made 10 months after the application was actually mailed.

It is for this reason that the Office has established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, which was long ago established and is well publicized, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See section 503, Manual Of Patent Examining Procedure (MPEP 503).

To reiterate, a properly itemized return postcard constitutes *prima facie* evidence that the items were filed on the date stamped thereon. Unfortunately, petitioners have not provided the date-stamped return postcard. Therefore, the Office has no way of verifying if the items listed thereon were filed on October 26, 2001.

Regarding petitioners' Express Mail argument, petitioners are advised that the provisions of 37 CFR 1.10(e) cannot be utilized to prove the contents of a mailing. MPEP 513 states, "Where there is a dispute as to the contents of correspondence submitted to the Office,...an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s)... were filed in the Office with such correspondence. Rather, where the records of the Office (e.g. the file of the application) contain any document(s)... corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP 503 containing specific itemization of the document(s)... purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s).. that is not among the official records of the Office."

As stated above, the postcard submitted in the instant case is not date stamped and therefore cannot be used to prove the October 26, 2001 filing date.

Since pages 19, 20, 21, 22, and 23 were not a part of the papers filed on October 26, 2001, the application cannot be accorded the October 26, 2001 filing date with those pages as part of the original disclosure of this application.

The petition is dismissed.

Of course, applicant may submit pages 19, 20, 21, 22, and 23 in the form of an amendment (see 37 CFR 1.121) for consideration by the examiner to determine whether or not the pages contain new matter compared to the original specification filed on October 26, 2001.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of October 26, 2001. Pages 19, 20, 21, 22, and 23 submitted with the instant petition will **not** be considered part of the original filing.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy